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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,400	07/15/2003	Joe F. Wells	5823-70103	9550
23643	7590	12/28/2004	EXAMINER	
BARNES & THORNBURG 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,400	WELLS, JOE F.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thanh K Truong	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 October 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 14-33 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14-33 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

1. This action is in response to applicant's amendment received on October 11, 2004.
2. Applicant's cancellation of claims 1-13 is acknowledged.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 32 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 32 is a dependent claim of claim 21, and claim 21 claims an apparatus that is pneumatically operated in both directions, however, claim 32 further claims that the device of claim 21 further comprises a manual actuator. The applicant's disclosure provides no support for a device that is having both pneumatic actuator and manual actuator in the same embodiment.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed above in paragraph 2 of this office action, from the applicant's disclosure, the pneumatically operated device and the manually operated device are not of the same embodiment. In other words, Applicant cannot claim a pneumatic apparatus and in the same claim claiming that the pneumatic apparatus also a manually operated device. Claim 32 is vague and indefinite, because it is unclear what is being claimed, a pneumatic driven piston device or a manually operated piston device. Furthermore, the device disclosed by the Applicant can only be operated either as a manually operated device or a pneumatic operated device, but not both as the same time.

Accordingly, claim 32 cannot be treated on its merits at this time.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

8. Claims 14, 17-19, 21-26 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Fehrs (3,583,496).

Fehrs discloses an apparatus (figures 1-3) comprising:

a magazine 79 configured to hold a plurality of fasteners and having an opening through which the fasteners are fed;

a pneumatic cylinder 2 having an upper portion and a lower portion, the cylinder being in fluid communication with a source of compressed gas;

a piston 5 having an upper end and an opposite lower end, the piston being disposed within the cylinder and moveable relative thereto;

a drive member 6 coupled to the piston and moveable therewith in a first direction across the opening of the magazine 79 by the compressed gas entering the upper portion of the pneumatic cylinder (figure 2) to drive a fastener into the ground, and moveable in an opposite second direction (figure 3) across the opening by compressed gas entering the lower portion of pneumatic cylinder.

Fehrs further discloses: a control apparatus 4 for controlling the actuator, and the control apparatus including a pneumatic valve 25, 42; the two pneumatic valves have a first default position and a second position (figures 1-3 show valves 25 and 42 move from default position to second position); the pneumatic actuator comprises a charging chamber 30, 76; the control apparatus in fluid communication with the charging chamber and the pneumatic cylinder and configured to control the introduction of compressed gas into the pneumatic cylinder (figures 1-3); the control apparatus 4 is disposed between the charging chamber 30 and the pneumatic cylinder 2; and the control apparatus comprises a first valve 25 configured to direct compressed gas into the upper portion of the pneumatic cylinder to drive the piston in the first direction and a

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second valve 42 configured to direct compressed gas into the lower portion of the pneumatic cylinder to drive the piston in the second direction.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehrs (3,583,496) in view of Lange (3,929,056).

As discussed above in paragraph 8 of this office action, Fehrs discloses the claimed invention, but does not expressly disclose that both of the control valves must be actuated in order to move plunger in the pneumatic cylinder.

Lange discloses an apparatus comprising a control apparatus for controlling the actuator and the control apparatus including two pneumatic valves 14, 15; wherein both valves must be actuated in order to move a plunger in the pneumatic cylinder (figure 4 & column 3, lines 20-34). Lange device provides a safety feature to protect the operator from accidentally activates the device.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fehrs apparatus by incorporating the control device as taught by Lange to provide safety feature to protect the user of the device.

11. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehrs (3,583,496) in view of Dorney (3,215,324).

As discussed above in paragraph 8 of this office action, Fehrs discloses the claimed invention, but does not expressly disclose that the magazine is removable and is configured to house fasteners of different dimension.

Dorney discloses an apparatus that the magazine is removable and is configured to house fasteners of different dimension (column 1, lines 9-18, lines 28-31 and lines 55-57). Dorney apparatus provides flexibility to the pneumatic fastener.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fehrs apparatus by incorporating the removable magazine as taught by Dorney providing flexibility to the pneumatic fastener.

12. Claims 14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange (3,929,056).

Lange discloses a fastener insertion device 1 for inserting fasteners in a substrate, the device comprising: a pneumatic actuator 4, 5; a fastener holder 7 configure to hold a plurality of fasteners (column 2, lines 28-29 & lines35-36); a fastener pusher 6 coupled for movement relative to the fastener holder, the fastener pusher being configured to engage an end of a fastener (figure 1 & lines 35-38); an actuator 4, 5 coupled to the fastener pusher, the actuator being configured to move the fastener pusher between an extended fastener-inserting position and a retracted position.

Lange further discloses: charging chamber 3; a control apparatus for controlling the actuator and the control apparatus including two pneumatic valves 14, 15; wherein both valves must be actuated in order to move a plunger in the pneumatic cylinder (figure 4 & column 3, lines 20-34); wherein the two pneumatic valves have a first default position and a second position, the actuator is actuated when the two pneumatic valves are in their second position (figures 1-4); wherein compressed air biases the plunger in the uppermost position (figure 1); a second actuator 14 including a handle 2 and an operator-driven piston 16 coupled to the handle (figures 1-4).

13. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Lange (3,929,056) in view of Dorney (3,215,324).

As discussed above in paragraph 12 of this office action, Lange discloses the claimed invention, but does not expressly disclose that the magazine is exchangeable with a second fastener holder.

Dorney discloses an apparatus that the magazine is exchangeable and is configured to house fasteners of different dimension (column 1, lines 9-18, lines 28-31 and lines 55-57). Dorney apparatus provides flexibility to the pneumatic fastener.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fehrs apparatus by incorporating the removable magazine as taught by Dorney providing flexibility to the pneumatic fastener.

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14. Claims 14, 16-26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (4,627,563) in view of Fehrs (3,583,496).

Meyer discloses an apparatus comprising: a pneumatic actuator 50; a fastener holder 130 configured to hold a plurality of fasteners 160; a fastener pusher 76 coupled for movement relative to the fastener holder, the fastener pusher being configured to engage an end of a fastener (figure 3); an actuator 50 coupled to the fastener pusher, the actuator being configured to move the fastener pusher between an extended fastener-inserting position (figure 5) and a retracted position (figure 2).

Meyer further discloses: charging chamber 52; and a control apparatus 90 including a pneumatic valve.

Meyer discloses the claimed invention, but does not expressly disclose that the pneumatically driven piston being biased by compressed air to move the fastener pusher.

As discussed above in paragraph 8 of this office action, Fehrs discloses an apparatus in which the pneumatically driven piston being biased by compressed air to move the fastener pusher.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Meyer so that the pneumatically driven piston is biased by compressed air to move the fastener pusher as taught by Fehrs. Fehrs apparatus provides a better and more effective device (column 1, lines 20-23).

15. The modified Meyer (and Fehrs) further discloses all the features as recited in claims 14, 17-19, 21-26 and 33 (see paragraph 8 of this office action).

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (571) 272-4472. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt  
December 15, 2004.



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